

24



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,576	11/25/2003	Shinichiro Kawasaki	81940.0064	5791
26021	7590	08/24/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			LAM, DUNG LE	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,576

Applicant(s)

KAWASAKI ET AL.

Examiner

Dung Lam

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Method and Apparatus for Downloading Digital Content via the shortest and lowest cost path".

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **1-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haller** (US Pub. No. 2004/0068570) in view of **Rautila** (US Patent No. 6714797).

4. **Haller** teaches a portable terminal that performs a plurality of functions to reproduce and execute digital contents, the portable terminal comprising:

a module that displays the list of contents (Fig. 7, Col. 6, para. 75)

a module (menu software component 414, Col. 6 para. 74) that provides a list of contents including estimated communication costs and download time (download prices and menu 703, Col. 6, para. 74) to obtain the respective

Art Unit: 2687

contents. **However**, Haller fails to disclose that the module also provides the locations of the contents. In an analogous art, **Rautila** teaches that the users can select which location they want to download the content from and that one provider location is a more economical choice than another (Col. 4, lines 41-64). Further, Haller teaches that the download rate is dependent on the user location and time (Col. 6, par. 79). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Haller's content downloading portable terminal with Rautila's teaching of providing the location to allow users to make better decision in selecting the contents that best fit their time and financial budget based on the location.

5. Regarding **claim 2**, **Haller and Rautila** teach all the limitations of in claim

1. They further teach that the estimated communication costs and the estimated communication times of the contents are calculated based on the locations of the contents and a current position of the portable terminal. (Haller's Col. 6, para. 79 and Rautila's Col. 6, 15-17).

6. Regarding **claim 3**, **Haller and Rautila** teach all the limitations of in claim

2. However they fail to teach a module that estimates a new communication path to a new location of the content which becomes available when moving the portable terminal by a specified distance, a communication time to obtain the content through the new communication path, and a communication cost to obtain the content through the new communication path. In an analogous art, Rautila teaches a mobile device that can receive information regarding the nearest hotspot network locations based on user's current location (Col. 8, lines

Art Unit: 2687

27-32 and Fig. 7) and also allows user to select which location to download the digital content from based on estimated time and a cost benefit analysis (Col. 4, lines 53-63 and lines 16-18). Therefore, it would have been obvious for one of ordinary skill in the art at the time of invention to modify Haller and Rautila's teaching to inform the mobile user of a new location and its associated new cost to allow user to make a best economical and informed choice in downloading a particular content.

7. Regarding **claim 4, Haller and Rautila** teach all the limitations of claim 3. Rautila further teaches a module that judges if the new communication path provides at least one of a shorter communication time (Col. 4, lines 59-63 and Fig. 7) and a lower communication cost than communication paths from the current location of the portable terminal to the locations of the contents.

8. Regarding **claim 5, Haller and Rautila** teach all the limitations in claim 4. Rautila further teaches a module that proposes to move the portable terminal to the new location when a positive judgment is made (Col. 4, lines 59-63 and Fig. 7).

9. Regarding **claim 6, Haller and Rautila** teach all the limitations in claim 5. Rautila further teaches a new communication path is proposed when the new communication path provides both a shorter communication time (Col. 4, lines 59-63 and Fig. 7). Rautilla further teaches an inherent lower communication cost path, his teaching of a cost benefit analysis for downloading the content (Col. 4, lines 59-63) implies that his teaching is capable of proposing a cost effective method of downloading. Therefore it would have been obvious for one of

ordinary skill in the art at the time of the invention to further include a lower cost path proposal to allow users to save some money by selecting the lower cost choice.

10. Claims **7 and 8** are rejected for the same reasons as claim 6.

11. Regarding **claim 9, Haller and Rautila** teach all the limitations in claim 3. Rautila further teaches a display device (200, Fig. 2) that inherently displays the locations of the contents as selectable items, and an inherent selection module that selects one of the locations of the contents displayed on the display device (Col. 6, lines 15-18 and Col. 4, lines 57-59). Since Rautilla discloses that the user can opt to download from either the electronic shop server or the hotspot network, it is inherent that the options has to be somehow displayed and the selected option has be processed by an inherent selection module.

12. Claim **10** is rejected for the same reasons as claim 9.

13. Regarding **claim 11, Haller and Rautila** teach all the limitations in claim 1. Haller further teaches in paragraph 56 that the digital contents include at least music data (ring tone), picture data (an image file, gif, jpeg) and program data (.EXE file).

14. Regarding claims **12-19**, they are similar to claims 1-8 with a few additional limitations. Therefore claims 12-19 are rejected for the same reasons as claims 1-8 with the following additional limitations. Haller also teach a content server (101 Fig.1 and para. 51) that is capable of recording digital contents including music data (ring tone para. 56), picture data (image para. 56), program

Art Unit: 2687

data (.EXE File para. 56); and a module (602 software transfer para. 51 and Fig.

8) that distributes the digital contents to a portable terminal.

15. Regarding **claims 20-29**, they are the method claims corresponding to the apparatus claims of 1-10 respectively. Therefore, they are rejected for the same reasons as claims 1-10.

Citation of Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fujii (US Patent No. 6804537) discloses a content distribution system of providing an adaptive menu that lists various sources of servers for users to select the content from.

Taib et al. (US Publication No. 2003/0177219) discloses a content distributing system that utilizing caching capability which allows users to access the data in a shorter period of time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Lam whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 8-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2687

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

08/22/2005



ELISEO RAMOS-FELICIANO
PATENT EXAMINER